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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Majestique Corporation		
Entity	Corporation	Citizenship	Puerto Rico
Address	Amelia Industrial Park Diana St. 27, Jose Flores Blg. #2 Guaynabo, PR 00968 UNITED STATES		

Attorney information	Gino Negreti, Esq. Negretti Law Offices Cond. Caribbean Towers, Ste. 17 670 Ponce de Leon Ave. San Juan, PR 00907-3207 UNITED STATES gnl@prtc.net Phone:787-725-5500

Applicant Information

Application No	85603453	Publication date	11/27/2012
Opposition Filing Date	12/10/2012	Opposition Period Ends	12/27/2012
Applicant	Ugobono, Vanessa 144 mimosa st, Sta. Maria San Juan, 00927 PR		

Goods/Services Affected by Opposition

Class 025. First Use: 2002/01/01 First Use In Commerce: 2002/01/01
All goods and services in the class are opposed, namely: Clothing for athletic use, namely, padded elbow compression sleeves being part of an athletic garment; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Clothing, namely, khakis; Combinations; Jackets; Jerseys; Leather belts; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Ties; Tops; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Wearable garments and clothing, namely, shirts; Women's clothing, namely, shirts, dresses, skirts, blouses; Wrist bands

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Torres v. Cantine Torresella S.r.l.Fraud	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85796366	Application Date	12/06/2012

Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	M MAHI MAHI		
Design Mark			
Description of Mark	The mark consists of a stylized letter "M" inside a square box with the words "MAHI MAHI" written underneath it and circles radiating outward from the drawing image.		
Goods/Services	Class 025. First use: First Use: 1998/12/19 First Use In Commerce: 1998/12/19 Adult novelty gag clothing item, namely, socks; Belts; Belts made out of cloth; Bottoms; Clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility; Clothing items, namely, adhesive pockets that may be affixed directly to the inside of clothing for storage and safekeeping of personal items; Clothing, namely, khakis; Eyeshades; Fitted swimming costumes with bra cups; Head wear; Headbands for clothing; Hoods; Infant wear; Jackets; Leather belts; Short sets; Sun protective clothing, namely, wetsuits; Surf wear; Swim suits; Swim trunks; Swim wear; Swim wear for gentlemen and ladies; Swimming trunks; Wearable garments and clothing, namely, shirts; Women's clothing, namely, shirts, dresses, skirts, blouses; Wrist bands		

Attachments	Cover Letter.pdf (1 page)(41522 bytes) Notice of Opposition.pdf (10 pages)(126153 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/gino negretti/
Name	Gino Negreti, Esq.
Date	12/10/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MAJESTIQUE, CORP. PLAINTIFF V. **VANESSA UGOBONO, D/B/A "MAHI MAHI"** DEFENDANT	**IN THE MATTER OF**: Trademark application Serial No. 85603453 **FOR THE MARK**: "Mahi Mahi" **PUBLISHED IN THE OFFICIAL GAZETTE ON**: November 27th, 2012

NOTICE OF OPPOSITION COVER LETTER

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MAJESTIQUE CORPORATION PLAINTIFF V. **VANESSA UGOBONO** DEFENDANT	**IN THE MATTER OF**: Trademark application Serial No. 85603453 **FOR THE MARK**: "Mahi Mahi" **PUBLISHED IN THE OFFICIAL GAZETTE ON**: November 27th, 2012

NOTICE OF OPPOSITION

The Plaintiff in the above-referenced matter is Majestique Corporation, a corporation duly organized under the laws of the Commonwealth of Puerto Rico with its business address being as follows: P.O. Box 193068, San Juan, Puerto Rco, 00919-3068.

The above-identified Plaintiff is the lawful owner of the trademark "Mahi Mahi" and will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

I. FACTS

1. **DEFENDANT'S ADDRESS**: Upon information and belief, Defendant is an individual with address in: 144 Mimosa St., Santa María, San Juan, Puerto Rico, 00927.

2. **APPLICATION**: On April 20th, 2012, the above-referenced Defendant, Vanessa Ugobono, allegedly d/b/a/ "Mahi Mahi" (hereinafter, "Defendant"), filed an initial application to register the mark "Mahi Mahi" (hereinafter, "the mark"), on or in connection with goods classified in International Class 25, **where it is falsely averred that she is the owner of the mark "Mahi Mahi" and that the latter was first in used in commerce in January 1st, 2002**.

3. **USE ANYWHERE AND IN COMMERCE**: **The mark was first used anywhere and/or in commerce on or around November 1st, 1998 by the Plaintiff's predecessor, Juan J. Fierres-González** (hereinafter, "Plaintiff's predecessor"), **d/b/a/ J.F. Distributor, Corp., on or in connection with the goods specified in the application object of this proceeding**. Furthermore, both the Plaintiff and its predecessor are professionals dedicated to the wholesale and distribution of clothing, that is, goods classified in International Class 25.

4. **PRIORITY OF USE**: The Plaintiff's predecessor, between November 1st, 1998 and August 1st, 2011, ***uninterruptedly*** **used the mark "Mahi Mahi" anywhere and/or in commerce, on or in connection with the goods above-mentioned** and, upon acquiring ownership over it, Plaintiff has used the mark in commerce accordingly as well.

5. **REGISTRATION IN PUERTO RICO, U.S.A.**: On or around June 1st, 1999, Fierres-González presented an application for the registration of the mark "Mahi Mahi"

in the Puerto Rico Trademark Office (hereinafter, "PRTO"). Said application eventually matured into a registration and, therefore, enjoys of the publicity that such record brings.

6. **AGREEMENT FOR THE SALE AND PURCHASE OF TRADEMARKS**: On August 1st, 2011, Fierres-González made and entered into an "Agreement for the Sale and Purchase of Trademarks" with the Plaintiff, Majestique, Corporation, **wherein Fierres-González sold to Majestique Corporation the exclusive rights, title and interest to a series of trademarks including, but not limited to, the trademark object of this proceeding, "Mahi Mahi".**
7. **VALIDITY OF CONTRACT**: The above-referenced contract was validly executed and, therefore, is legally binding and enforceable.
8. **CONTINUING USE IN COMMERCE**: Plaintiff further asserts that ever since acquiring the exclusive rights, title and interest of the mark "Mahi Mahi" he has continued its commercial use **in an *uninterrupted* manner**, on or in connection with the goods above-mentioned. Additionally, Plaintiff asserts that he has not abandoned its commercial use under any circumstance at any time since acquiring the exclusive rights, title and interest of the mark.
9. **LOGO/LABEL/MARK DRAWING**: Notwithstanding the aforesaid, on or around November 3rd, 2000, the Plaintiff's predecessor, d/b/a J.F. Distributor, Corp., contracted with a corporation called Unitex, Inc., for the manufacturing and design of a new logo to be used on or in connection with the mark, "Mahi Mahi". ***Said logo is the exact same mark drawing that the Defendant pretends to***

claim as her own in the above-identified application. In plain, ***the referenced logo is property of the Plaintiff***.

10. **PREVIOUS RELATIONSHIP**: Upon information and belief, on or around December 23th, 2000, the Defendant, Vanessa Ugobono, contracted marriage with Juan Pablo Fierres-Santiago, the son of the Plaintiff's predecessor. Their marriage was later irretrievably broken and dissolved by a competent court of law.

11. **FALSE MATERIAL REPRESENTATIONS**: As a result of her relationship with the Plaintiff's predecessor, **Defendant knew, *prior to the filing of her application*, that her former father-in-law was the lawful owner of the mark "Mahi Mahi" at the time** and, therefore, also knew of the priority of use of said trademark by the Plaintiff's predecessor, on or in connection with the goods above-mentioned.

II. GROUNDS FOR OPPOSITION

12. **SECTION 13 OF THE LANHAM ACT**: Pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063(a), "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register… may… file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of the mark sought to be registered."

13. **SECTION 2(d) OF THE LANHAM ACT**: Moreover, Section 2(d) of the Lanham Act, 15 USC § 1052(d) provides, in relevant part: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be

refused registration on the principal register on account of its nature **unless it… [*c*]onsists or comprises a mark… or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake or to deceive** (**emphasis supplied**)[.]"

14. **BURDEN OF PROOF**: According to the precedential case of *Life Zone, Inc*. v. *Middleman Group, Inc*.[1], this Honorable Court explained that "[i]n an opposition, the [Plaintiff] bears the burden of proving, by a preponderance of the evidence, a substantive ground for refusal to register the subject trademark." Moreover, "[**i**]**n a likelihood of confusion case under Trademark Act Section 2(d), this burden requires [Plaintiff] to prove that it has *some* *prior trademark right and that [Defendant's] mark is likely to cause confusion with that trademark*** (***emphasis supplied***)."[2]

15. **NON-REGISTERED RIGHTS OF A SENIOR USER**: To that effect, it should be noted that "[**n**]**either application for, nor registration of, a mark at the federal level wipes out the prior non-registered, common law rights of others**. (**emphasis supplied**)."[3]

16. **PROPRIETARY RIGHTS & PRIORITY OF USE**: Moreover, in the also precedential *Giersch* v. *Scripps Network, Inc*.[4], this Honorable Court subsequently

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[1] *Life Zone, Inc*. v. *Middleman Group, Inc*., 87 USPQ2d 1953 (T.T.A.B. 2008).
[2] *Id.*
[3] J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition,* West Publishing, 2003, § 16:2 (4th ed. 2006).
[4] Giersch v. Scripps Network, Inc., 90 USPQ2d 1020 (T.T.A.B. 2009).

stated, in pertinent part, that "[**i**]**n order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the mark must be distinctive**, inherently or otherwise, **and plaintiff must show priority of use** (**emphasis supplied**)." To those effects, the Court further purported that "[**a**] **party may establish its own prior proprietary rights in a mark through** ownership of a prior registration, **actual use** or through use analogous to trademark use… (**emphasis supplied**).[5]

17. **PRIORITY DISPUTES**: Moreover, "[f]or purposes of priority of use under common law or Lanham Act … § 2(d) priority disputes, some form of pre-sales publicity or sales solicitation may suffice to prove priority over a rival user."[6]

18. **DU PONT FACTORS**: Notwithstanding the preceding, it is imperative to keep present the analysis made by the former Court of Customs and Patent Appeals (C.C.P.A.) regarding Section 2(d) of the Lanham Act in the landmark case of *du Pont*[7], and the factors therein established. According to the decision, among some of the factors that must be considered in testing for likelihood of confusion under Section 2(d), *supra*, are: (i) **similarity or dissimilarity of the marks in their entireties as to appearance**, sound, connotation and commercial impression; (ii) similarity or dissimilarity as well as **the nature of the goods or services as described in an application or in connection with which a prior mark is in use**; (iii) the **similarity or dissimilarity of the trade channels** to be used by the parties'; (iv) the **extent of potential confusion** (*i.e.* whether *de*

[5] *Id.*
[6] *Id.*
[7] *In re E. I. du Pont de Nemours & Co*., 476 F.2d 1357 (C.C.P.A. 1973).

minimis or substantial); and, (v) any other established fact probative of the effect of use, among others.[8] Moreover, it clarified said factors and/or evidentiary elements listed above are not in any order of merit; rather, each may, on a case by case basis, play "a dominant role".[9]

19. **IDENTICAL MARKS & LIKELIHOOD OF CONFUSION**: One such case were identical marks were object of an opposition proceeding is that of *Kohler Co*. v. *Baldwin Hardware Corp*.[10]. There, this Court held that in cases such as this one, "[t]he issue, of course, is not whether purchasers would confuse the goods, but rather **whether there is a likelihood of confusion as to the source of the goods**." It further held that "**where identical marks are involved, *as is the case here*, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines** (citations omitted; ***emphasis supplied***)."

20. **CHANNELS OF TRADE**: Lastly, with regards to the channels of trade factor, *du Pont*, *supra*, the Court stated that "**[w]here there is no limitation on the channels of trade in the identification of goods in the subject registration, it is presumed that the goods move in all normal channels of trade**…"[11], therefore creating a substantial risk of the goods being sold in a manner that they would appeal to an overlapping audience of the general public (**emphasis supplied**).

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[8] *Id.*
[9] *Id.*
[10] *Kohler Co*. v. *Baldwin Hardware Corp*., 82 USPQ2d 1100 (T.T.A.B. 2007).
[11] *Id.*

21. **SECTION 38 OF THE LANHAM ACT**: Notwithstanding the aforesaid, according to Section 38 of the Lanham Act, 15 U.S.C. § 1120, "[**a**]**ny person who shall procure registration in the Patent and Trademark Office or a mark by a false or fraudulent declaration or representation… *or by any false means*, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof** (***emphasis supplied***)."

22. **FRAUD**: According to the landmark case of *Torres* v. *Cantine Torresella S.r.l.*[12], "[f]raud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." In that sense, the Federal Circuit recently held that "… **a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO** (**emphasis supplied**)."[13]

23. **CLEAR AND CONVINCING EVIDENCE**: However, and recognizing the difficulties intrinsic to the availability of direct evidence of "deceptive intent", the Federal Circuit further held that "… ***such intent can be inferred from indirect and circumstantial evidence***" but that "such evidence must still be clear and convincing… in light of all the evidence" as to indicate "sufficient culpability [as] to require a finding of intent to deceive (***emphasis supplied***)."[14]

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[12] *Torres* v. *Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986)
[13] *In re Bose Corporation*, 580 F.3d 1240 (Fed. Cir. 2009).
[14] *Id.*

III. CONCLUSION

Plaintiff is the lawful owner of the mark and logo shown in the above-identified application (*i.e.* "Mahi Mahi"). **Moreover, *the mark owned by Plaintiff and the mark that Defendant seeks registration for are one and the same***; they are identical in sound (*i.e.* phonetically), appearance, meaning and commercial impression. Additionally, the classified goods specified in the above-identified application to be used on or in connection with the mark "Mahi Mahi" are not only related but pretty much identical also. Moreover, not having the Defendant limited the channels of trade in the identification of goods in the subject registration, it is presumed that said goods move in all normal channels of trade and, therefore, they both ultimately appeal to an overlapping audience of the general public. **It is clear that the application herein contested, is not only likely, but guaranteed, to cause confusion, mistake and/or deceit as to as to the source of the goods sold/used on or in connection with the mark "Mahi Mahi"**. What is more, in light of the preceding, and taking into consideration the Defendant's relationship to the Plaintiff's predecessor, it is even clearer that her application, and the contents therein stated, is not the result of "an honest misunderstanding or inadvertence"[15] but rather a willful intent to deceive the PTO.

On the other hand, *arguendo* that Defendant's misstatements do not represent a conscious effort to obtain a registration for her alleged business that she knew she was not entitled to, it is evident that registration of the mark shown in the above-identified application would directly damage the Plaintiff's investment on the mark

[15] *Id.*

"Mahi Mahi" as well as his overall business. In sum, not only is the resulting likelihood of confusion guaranteed, to the extent that both marks are identical, but it is in the public interest that Defendant's application be denied registration, insofar any other course of action would contravene the Plaintiff's lawfully acquired proprietary rights over the mark "Mahi Mahi" under Puerto Rico state law as well as cause an unlawful and irreparable damage to the Plaintiff's overall business.

WHEREFORE, Plaintiff respectfully requests:

That judgment be entered in favor of Plaintiff and against Defendant, denying registration of the mark shown in the above-identified application as requested by Defendant; as well as any such other and further relief to Plaintiff as it may deem just and proper.

I HEREBY CERTIFY that a true and exact copy of this "Notice of Opposition" has been sent on this day by mail to the Defendant's attorney of record, Christopher J. Day, at the following address: Law Office of Christopher Day, 9977 North 90th Street, Suite 15, Scottsdale, Arizona 85258, United States.

RESPECTFULLY SUBMITTED.

By: /Gino Negretti/ **Date**: December 10th, 2012.

ATTORNEY FOR PLAINTIFF